

## REMARKS

### 1. Support for the amendments and new claim

The amendments to claims 30 and 64, as well as new claim 66, are supported, for example, on page 69 lines 6-19 and page 69 line 21 to page 71 line 3, and thus the amendments do not constitute new matter. During a conference call with the examiner and her supervisor on June 30, 2004, it was agreed that the amended claim, with its recitation of image analysis techniques for cytoplasmic and membrane masking was supported in the specification as filed.

### 2. Rejection under 35 USC 112, second paragraph

The first paragraph of 35 USC §112 requires that the specification shall contain a written description of the invention. "To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." MPEP 2163, discussing *Vas-Cath Inc., V. Mahurkar*, 935 F.2d 1555, 1563 (CAFC 1991). "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention." MPEP 2163, discussing *Lockwood v. American Airlines, Inc.*, 107 F.3d at 1565, 1572 (CAFC 1997).

"The examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims." MPEP 2163 (II)(3)(b) citing *Wertheim*, 541 F.2d at 263.

During a conference call with the examiner and her supervisor on June 30, 2004, it was agreed that amended claim 30 and its recitation of separate cytoplasmic and plasma membrane masking by use of the recited image analysis techniques was supported in the specification. For the sake of completeness, the Applicants will nonetheless respond to the rejection.

In the present case, the patent office has asserted that the amendment made in the office action response filed January 23, 2004 constituted new matter. Specifically, the patent office stated that:

"Consideration of the support pointed to by Applicants regarding amending the claims to cite 'plasma' membrane instead of 'cell' membrane on pages 68-70 reveals that this amendment is NEW MATTER. No masking is cited on page 68. On page 69, lines 11-14, images of probes used to mark the 'plasma

interview  
summary  
is NOT OK  
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